REMARKS

This Application has been carefully reviewed in light of the Office Action mailed July 11, 2006 ("Office Action"). Claims 1-27 are pending in the application. Of the above claims, Claims 12-25 have been withdrawn from consideration. The Examiner has rejected Claims 1-11 and 26-27. Applicant amends Claim 1 and Claim 26, cancels Claim 9, and respectfully requests reconsideration and allowance of all pending claims. Applicant does not admit that any amendment was necessary as a result of any cited art.

Claim Rejections - 35 U.S.C. § 102

The Examiner rejects Claims 1-3, 7-9, 11 and 26-27 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2005/0024544 A1 to Waight, et al. (*"Waight"*). Applicant respectfully requests reconsideration and allowance of Claims 1-3, 7-8, 11 and 26-27.

The Examiner states that claims 1, 3, 7-9, 11 and 26-27 are anticipated by *Waight*. Claim 9 specifies a filter that "dissipates . . . undesired channels . . . in elements of the integrated circuit such that the undesired signals are not reflected back to a transmitter of the input signal." Although the Examiner rejects Claim 9 in view of *Waight*, the Examiner fails to point to any specific teaching in *Waight* which meets this element. "A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Instead, the Examiner points only generally to the pre-select filter and tuner of *Waight* being on the same chip (Office Action, page 3), but does not in any way address how undesired channels are dissipated. Accordingly, Applicant respecfully traverses the Examiner's rejection of Claim 9. Claims 1 and 26 are currently amended to incorporate the elements of Claim 9, now cancelled. For at least these reasons, Applicant respectfully requests reconsideration and allowance of amended Claims 1 and 26 and their respective dependent claims, specifically Claims 3, 7-8, 11, and 27.

In addition to the foregoing arguments, Applicant further traverses the rejection of Claim 3, which recites, in part, "the filter comprises a plurality of stages and is switchable among the plurality of stages." The Examiner does not cite any item in *Waight* that teaches, suggests, or discloses this element. Instead, the Examiner points only generally to the pre-

select filter and tuner of *Waight* being on the same chip (Office Action, page 3). Again, this is not enough. As stated above, anticipation requires that "each and every element" be found in a single prior art reference. *See id.* *Waight* does not teach, suggest, or disclose the elements of Claim 3.

Claim Rejections - 35 U.S.C. § 103

The Examiner rejects Claims 4-6 and 10 under 35 U.S.C. 103(a) as being unpatentable over *Waight*. Claims 4 -6 and 10 depend from Claim 1, shown above to be allowable. Claims 4-6 and 10 are allowable for at least this reason.

Furthermore, Applicant respectfully traverses the Examiner's arguments regarding Claims 4-6 and 10. With respect to Claims 4-6, the Examiner states that "Waight does not explicitly recite the components used in the pre-select (first filter)." The Examiner goes on to argue that the elements comprising the tracking filters (i.e. 240, 242, 244 and 246) in *Waight* can be applied to the first filter. There are two problems with the Examiner's reasoning. First, contrary to the Examiner's statement, *Waight* does in fact describe the components used in its pre-select filter. For example, in Figure 11, which is described in paragraph 19, *Waight* describes an embodiment of the pre-select filter 202 comprising two inductors, two fixed capacitors, two switches, and a two-state digitally tunable capacitor. Therefore, Figure 11 describes a filter that is different from the filter described in Claims 4-6. Hence, the use of a filter comprised of at least one stage that "is switchable among a plurality of capacitors" is not taught by *Waight*; indeed, *Waight* teaches away from such a configuration. "A prior art reference must be considered in its entireety, i.e., as a *whole*, including portions that would lead away from the claimed invention." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); MPEP § 2141.02. Second, the Examiner points to no motivation or suggestion to configure the pre-select filter of *Waight* in a way similar to the tracking filters of *Waight*. "[T]here must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. . . ." MPEP § 2143. To the extent that the Examiner finds it common knowledge or well-known in the art to configure the pre-select filter of *Waight* in a way similar to the tracking filters of *Waight*, Applicant traverses the Examiner's assertion and respectfully requests the Examiner to provide documentary evidence to that effect as required under 37 C.F.R. 1.104(c)(2). *See*

also In re Zurko, 258 F.3d 1379, 1386, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001) ("[The Examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test.), and MPEP § 2144.04(c).

For at least the reasons stated above, Applicant respectfully requests reconsideration and allowance of Claims 4-6 and 10.

CONCLUSION

If there are matters that can be discussed by telephone to further the prosecution of this Application, Applicant invites the Examiner to call the undersigned attorney at (214) 953-6581 at the Examiner's convenience.

Applicant believes that no fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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